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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/805,898	03/22/2004	Michael H.B. Stowell	00-356-D	1941

7590 10/09/2007  
McDonnell Boehnen Hulbert & Berghoff LLP  
32nd Floor  
300 S. Wacker Drive  
Chicago, IL 60606

EXAMINER
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AKRAM, IMRAN

ART UNIT	PAPER NUMBER
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1797

MAIL DATE	DELIVERY MODE
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10/09/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/805,898	<b>Applicant(s)</b> STOWELL, MICHAEL H.B.	
	<b>Examiner</b> Imran Akram	<b>Art Unit</b> 1743	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 27 July 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 3,7-9,13-15 and 18-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-6,10-12,16 and 17 is/are rejected.
- 7) ☒ Claim(s) 21 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>1/26/05</u> .   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election of Group I in the reply filed on 7/27/07 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
2. Claims 3, 7-9, 13-15, and 18-20 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to nonelected species and methods, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 7/27/07.

### ***Claim Objections***

3. Claim 1 is objected to because of the following informalities: the word "from" in line 4 is meant to be the word "form." Appropriate correction is required.
4. Claim 21 objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from any other multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claim has not been further treated on the merits. It should be noted, however, that claim 21 recites the limitation "R<sup>1</sup>," R<sup>3</sup>," and "R<sup>5</sup>" in claim 1 and there is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 16, and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Anderson (US 6,437,150 B1).
7. Anderson discloses a composition for variably releasing fragrances comprising in combination: (a) a first organic agent that undergoes an intramolecular photochemical rearrangement (column 3, line 67 to column 4, lines 1-3) that is induced by sunlight radiation (column 4, lines 7-17) to release a fragrance or form a second agent that is a fragrance (column 7, lines 8-15); and (b) a carrier for topical administration to skin or hair or administration to articles of clothing and other textiles via washing or spraying methods (column 12, lines 58-67).

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. Claims 2, 4-6, and 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson ('150) in view of Rock (US 6,022,529).

11. Anderson discloses the use of molecules that undergo photochemical transformation to emit a smell. These molecules contain fragrance precursors (see abstract) and are to be used in topical creams and sprays for human hygiene products (column 12, lines 58-67). One such fragrance molecule is what Anderson refers to as an organoleptic alcohol (see molecule 4 in column 5). This chain has an aroma and is the byproduct of photo-activation. Anderson teaches this molecule to be attached to a variety of ketones, esters, and other oxygen containing organic compounds. And while Anderson discloses many different structures appropriate for photochemical rearrangement, Anderson does not disclose the specific structure of Applicant's species. Rock (and applicant himself), however, discloses a structure identical to applicant's sans the fragrance molecule (see claim 3). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the composition of Rock with the invention of Anderson. The purpose of Anderson's invention is nearly identical to that of applicant's and the specific structures are known in

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the art. The R<sup>1</sup> group of Rock could be substituted rather easily with the molecule disclosed in Anderson to achieve the same purpose as Anderson. The claim would have been obvious because the substitution of one known element for another would have yielded predictable results to one of ordinary skill in the art at the time of the invention. Thus all generic claims read on Anderson in view of Rock are rejected, including the elected species.

12. In regards to claim 5 and 6 specifically, Anderson discloses an auxiliary fragrance (column 7, lines 18-25) and column 5 reveals that the original molecule will photorearrange to become a fragrance.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Imran Akram whose telephone number is 571-270-3241. The examiner can normally be reached on 9-5 Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Walter Griffin can be reached on 571-272-1447. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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WALTER D. GRIFFIN  
SUPERVISORY PATENT EXAMINER